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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appn. Number 09/872,914

Appn. Filed 06/01/2001

Applicant pro se Ferdinand Schermel

Title Tilttable Modular Recycle Container System

Examiner Stephen J. Costellano

Art Unit 3727

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APR 15 2005

Appeal Brief originally filed Aug. 23, 2004
response to defect Oct. 17, 2004Assistant Commissioner for Patents
Washington, D.C. 20231

total no. of pages of text 19

REPLY BRIEF

Date April 15, 2005

(8) Evidence Relied Upon

The statement at lines 8-10 of the Grounds of Rejection 1 (as indicated by italics) which is relied upon by the examiner must be read in its context which preceded by to fully understand the reference. Applicant includes lines 4-7 of the Grounds of Rejection 1 to clarify:

Under 35 U.S.C. 113 are "The applicant shall furnish a drawing where necessary for the understanding of the subject matter". In this case not even the original Fig. 1 or the provisional patent drawing or the amended Fig 1 drawings (appendix 2) are necessary for someone skilled in the art to understand and reproduce the invention from the written portion of the disclosure, but with *the original drawings combined with the written disclosure, the various configurations are obvious and simply duplication and in any way adds new matter or additional features that was not part of the original disclosure.*

The applicant in this statement is arguing that the alleged new matter of the second attachable container is an obvious variation of the original disclosure when the original figure with a wheeled container with one attachable container combined with the original claim 2:

"2. The system of claim 1 further including a plurality of attachable containers stacked and secured on top of said attachable container."
and would be apparent to someone skilled in the art.

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The examiner relies upon evidence:

Lines 7 and 8 of page 16 of the brief filed November 18, 2004 "Both Tiramani's and the luggage industry have devices having the same base perimeter dimensions of approximately 170 inches."

This should read 170 square inches and not inches The applicant apologizes for this typographic error.

Applicant sites Page 19 of the appeal brief lines 3 and 4 states:

"- Tiramani teaches a total volume of 22 gallons with the wheeled container and 3 fastened containers, which follows or is similar to the teaching of luggage devices that are stacked. Both Tiramani's and the luggage industry's teaching has resulted in devices having the same base perimeter dimensions of 170 square inches."

The applicant means to convey that the area of the base with respect to the outer perimeter of that base, is 170 square inches and not 170 linear inches about the perimeter. The applicant has never meant to say that some luggage or Tiramani's tool box is 50 inches wide by 35 inches deep to produce a total perimeter dimension of 170 linear inches of perimeter (i.e. $35'' + 50'' + 35'' + 50'' = 170''$). Tiramani's tool box is approximately 17 inches wide and 10 inches deep. Ironically it is the object of the applicants invention to be able to have a wheeled container 50" wide by 35" deep with a height of say 12" so that it would still be light enough to lift when full of say newspaper but tiltable and rolled by the attachment of enough attachable containers to bring the overall height of the stack to a comfortable rolling height.

The examiner relies upon evidence:

Appellant has previously stated that the species contained in this application are not patentably distinct and unpatentable over each other in lines 8-10 of the request for supervisory review filed February 3, 2003 as paper No. 23.

The following is a copy of the review:

Feb. 3 /2003 No. of pages including this one: 4 and 1 page of drawing

Re: Applicant requests supervisory review of examiner's position of the applicants filing of the RCE not being proper.

Sir:

The applicant respectfully requests a supervisory review as applicant and examiner have been unable to proceed further. Applicant has presented clear and specific arguments but has not received specific responses and, in some instances, any response to arguments. The applicant realizes his limited understanding of the process and rules and reluctantly asks again for supervisory review of the examiner's response and position, as an appropriate next step.

The applicant has outlined how MPEP 806.04 (f, h, e,), and has also added (b) in this paper, prove that the claims of the RCE pertain to the elected invention. Applicant has submitted detailed arguments of how the tests of the MPEP rules support that : claims 1 and 2 are not mutually exclusive, that they are not patentably distinct and unpatentable over each other, that there is no distinction between species, and the claims have a commonality of operation, function and effect. These prove that the restriction

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requirement cannot be sustained and that the claims submitted are the elected invention, making the RCE fully responsive and proper.

Since the examiner will not respond to the arguments of how the claims are supported by all of the MPEP rules, rendering proof that there is no distinction of "another specie", but insists that they are directed to "another specie", the applicant respectfully requests that the examiner or supervisor defines the other species in reference to the claims and MPEP rules.

Since the examiner remains unconvinced that the language "at least one attachable container" does not include two nor a plurality of attachable containers, nor responds to the question of this language, applicant respectfully requests that the supervisor would either convince the examiner that at least one includes two, or if in agreement with the examiner, provide an explanation why it does not.

Applicant also requests reference to the MPEP rule or other rule that would not allow the claimed priority to the provisional patent, which shows a wheeled container with two attachable containers (PET page 5 of 5), to support and demonstrate reduction to practice of the configuration in question, as well as not being new matter.

The applicant in this reply brief will also include the original claims:

1. A modular wheeled container system that is tilted from the free standing position for rolling comprising:
 - a) a wheeled container having a means for rolling
 - b) at least one attachable container, and
 - c) a means for securing adjoining said wheeled container to said attachable container.
2. The system of claim 1 further including a plurality of attachable containers stacked and secured on top of said attachable container.

The applicant in this reply brief will also include the PETITION UNDER CFR 1.181 sent Jan 31/2003:

Applicant would respectfully add to the omission or correction submitted November 23, 2002, the following considerations to support that claim 2 is part of the elected invention:

With regards to MPEP 806.04(f). "Claims restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that when one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species". In this patent "at least one attachable container" includes "a plurality of attachable containers" and therefore claims 1 and 2 are not mutually exclusive and cannot be restricted to different species.

With regards to MPEP 806.04(h) the species must be patentably distinct from each other. Restriction should not be required if the species claimed are considered clearly

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unpatentable over each other. The forming of a rigid entity is the issue pertaining to the elected species. Suppose a configuration of a wheeled container having two attachable containers as claimed in claim 1 ("at least one attachable container", but in this instance two attachable containers). Such a configuration would be identical to the configuration described or claimed by claim 2 where in this instant case a plurality of two attachable containers is selected. Both claim 1 and 2 in this instance would be clearly unpatentable over each other.

With regards to MPEP 806.04(e) claim 1 and 2 have a commonality of operation, function and effect in that they both form the rigid entity and are both secured in the same manner.

With regards to MPEP 806.04(b) for "at least one attached container" and "a plurality of attached containers" (secured to said wheeled container) are not independent and in order to sustain a restriction requirement, distinction must be shown. Distinction is proven if it can be shown that the intermediate product is useful other than to make the final product. The wheeled container with at least one attached container secured at their adjoining interface produces the final product of a rigid entity that can be tilted for rolling. Similarly, a wheeled container with a plurality of containers secured at their adjoining interface produces the final product of a rigid entity that can be tilted for rolling. The forming of the rigid entity by securing adjoining containers is the object, function, and final product of the invention. The examiner has not given an example of an alternate use to prove distinctness therefore the restriction of claim 2 cannot be sustained if there is no independent species.

The applicant believes that the above context in which the distinction of species is discussed is relevant to understanding that the "not patentably distinct statement and unpatentable over each other" was intended to clarify that the second attachable container is part of the invention and should not be construed as an admission of obviousness of the claim. The subject matter of species is extremely difficult for this pro se inventor in this first patent application to understand. It is still unknown why this statement in the **Evidence Relied Upon** is condemning or accusatory in regards to this application, and an explanation is required in order for the applicant to further argue a defense.

112 Rejections

(9) **Grounds of Rejection 3A.** (Applicant resubmits pertaining arguments to accommodate the split of 3 into 3A and 3B)

For claims 1, 3-6, 9, 10, 22 and 24-26 regarding the second attachable container as well as the base perimeter greater than 55 as new matter added which was not described in the specification in such a way as to reasonably convey to someone skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 3, 4 and 22 pertains to tilted for rolling hitching of single tilted for rolling containers, refuse containers, single rigid entities, or combinations thereof, and are patentably distinct regardless whether or not the rigid entity has one or two attachable

attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 9 further limits the hitch to remain connected while tilting and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 24 is the new use for the Perbrache handle for securing attachable containers such as a recycle bin to the refuse container, attachable container to each other or to wheeled containers, or as part of a hitch and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported. Since this rejection has no relevance to this claim the applicant requests that the rejection is withdrawn for this claim.

Claim 25 and 26 pertain to the attachable container which fits specifically on the conventional RUBBERMAID 32 gallon refuse container, instead of a lid, and are patentably distinct regardless whether or not the rigid entity has one or two attachable containers on the wheeled container nor the 55 inch base perimeter dimension is supported since only a single attachable container is secured on the 32 gallon RUBBERMAID refuse container is claimed and the base perimeter is that of the 32 gallon RUBBERMAID refuse container. Since this rejection has no relevance to these claims the applicant requests that the rejection is withdrawn for these claims.

Claim 6 specifies the means for securing attachable containers and are patentably distinct